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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,759	07/10/2001	Avi Ashkenazi	10466/59	9581
9157	7590	11/10/2003	EXAMINER	
GENENTECH, INC.			MOSHER, MARY	
1 DNA WAY			ART UNIT	
SOUTH SAN FRANCISCO, CA 94080			PAPER NUMBER	

1648

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/902,759

Applicant(s)

ASHKENAZI ET AL.

Examiner

Mary E. Mosher, Ph.D.

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 39-44.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

Claims 39-44 remain rejected under 35 U.S.C. 102(e) as being anticipated by Lal et al 5,942,606 for reasons of record.

### ***Response to Arguments***

Applicant argues that the publications by McNicholl and Struyf deal with altering a naturally occurring receptor, not comparing two different receptors, and therefore are not probative of whether a viral receptor must be highly homologous to CAR in order to be functional. However, applicant relies entirely upon similarity in structure to CAR to infer function and usefulness as a viral receptor in the disclosure on the claimed priority date. The cited art is very relevant because it addresses the issue of the relationship between structure and function for virus receptors, and it teaches that minor changes in structure (truncation, alteration) can have major effects upon function in a virus receptor protein. Applicant's naturally occurring protein has larger changes in structure compared to the most similar known virus receptor, and therefore the unsupported assertion of function as a virus receptor (based upon the degree of similarity in structure) would not be unquestioningly accepted by those skilled in the art.

Applicant argues that the prior art, specifically Tomko et al page 3352, provides a general virus assay. The examiner fails to see where Tomko provides evidence of general knowledge in the art of a routine assay to discover an actual virus which can bind to a hypothetical receptor. Tomko was working with known viruses and a functionally defined receptor, obtaining a nucleic acid encoding the receptor and

determining the structure of the nucleic acid and protein receptor. Here applicant has defined a structure and sought, as of the claimed priority date, to infer similarity in function based upon a modest similarity in structure to a known virus receptor CAR. The previous rejections provide sound scientific reasons to doubt that asserted function, because the regions most similar to the virus receptor CAR are found in a nonessential region of CAR, and the region of CAR which functions by interacting with a virus shows little or no similarity to applicant's sequence. Even if the protein actually can act as a receptor for some virus, the priority document does not identify any specific virus which interacts with the putative receptor, requiring those skilled in the art to perform experimentation to discover a specific use for this specific protein.

Applicant argues that "To serve as an anticipating reference, the reference must enable that which it is asserted to anticipate," and points out that the disclosure in Lal is very similar to the disclosure in the priority document. Without commenting at all on the validity of patent 5,942,606, the examiner notes that the facts in the cited case law all involve the "how-to-make" aspect of enablement, where the issue is whether or not the asserted prior art put the claimed product in the possession of the public. An anticipatory reference is not required to even disclose a use for a product, see *In re Schoenwald* (CAFC) 22 USPQ 1671.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is 703-308-2926. The examiner can normally be reached on M-T and alternate F.

Application/Control Number: 09/902,759  
Art Unit: 1648

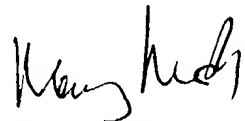
Page 4

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone number for all official responses is now 703-872-9306.

Effective January 2004, the phone number for examiner Mosher will be (571) 272-0906, and for SPE Housel will be (571) 272-0902.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

11/7/03

  
**MARY E. MOSHER**  
**PRIMARY EXAMINER**  
**GROUP 1600 / 1600**